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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/026,199  
Applicant: Thomas J. Lanoue et al.  
Filed: December 21, 2001  
TC/AU: 2832  
Examiner: Tuyen T. Nguyen

Confirmation No. 8442

Docket No.: 25653.0006.0  
Customer No.: 30166

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

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Date of Deposit August 28, 2003

I hereby certify that this paper, which is a Reply to Office Communication of July 28, 2003 (our file no. 25653.0006.0), and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Mailed By: Brandi A. Mitchell  
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**REPLY**

Sir:

In response to the Office Communication of July 28, 2003, Applicant herein replies to the Examiner's restriction requirement.

If any fees for the accompanying response are required, Applicant requests that this be considered a Petition therefor. The Commissioner is hereby authorized to charge any fees which may be required to Deposit Account 09-0528.

**Remarks/Arguments** begin on page 2 of this paper.

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**Remarks/Arguments:**

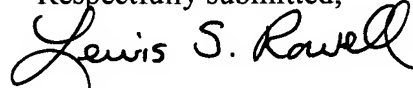
Claims 1-11 are pending in the applicant. The Examiner asserts that the application claims three distinct inventions: Invention I (Claims 1-3) drawn to a cooling duct; Invention II (Claims 4-6) drawn to a transformer; and, Invention III (Claims 7-11) drawn to a method of manufacture.

The Examiner asserted that Invention II, the transformer, has separate utility from Invention I, the cooling duct, such as a transformer not using the cooling duct of Invention I. Applicant respectfully disagrees and traverses the Examiner's Restriction of Inventions I and II. First, in order to establish that combination and subcombination inventions are distinct, two-way distinctiveness must be demonstrated, as well as other reasons such as classification and field of search. See MPEP 806.05(c). With respect to two-way distinctiveness, inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability, **and** (B) the subcombination can be shown to have utility either by itself or in other and different relations. In short, both requirements must be met.

The combination of Claims 4-6 (the transformer) does require the particulars of the subcombination (the cooling duct) of Claims 1-3. The first element, therefore, is not met and the restriction between Inventions I and II is not proper. Further, however, the Examiner has not met his burden of suggesting an example of separate utility for the cooling duct (Claims 1-3).

For purposes of submitting a complete reply, Applicant herewith elects, with traverse, Invention I, however respectfully requests that the Examiner withdraw the restriction between Inventions I and II of the pending application. Therefore, Applicant requests an examination of Claims 1-6.

Respectfully submitted,



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Date: August 28, 2003  
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